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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/620,276

07/14/2003

Glenn Sherburne

7744

24978

7590

12/07/2005

GREER, BURNS & CRAIN  
300 S WACKER DR  
25TH FLOOR  
CHICAGO, IL 60606

EXAMINER

PAYNE, SHARON E

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

18

<b>Office Action Summary</b>	Application No. 10/620,276	Applicant(s) SHERBURNE, GLENN	
	Examiner Sharon E. Payne	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.  
 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 8-20 and 23-25 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-4, 8-20 and 23-25 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)     | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 14, 15, 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brenchley et al. (U.S. Publication 2004/0246711 A1) in view of Jensen et al. (U.S. Publication 2003/0035291 A1). (Brenchley et al. is an appropriate reference because the subject matter referenced in the rejections is covered in the original application from which the Continuation-in-part application depends; the original application was filed on May 18, 2001.)

Regarding claim 1, Brenchley et al. discloses a wax body (abstract) with an internal cavity therein (last figure in publication, bottom), the wax body having a substantially flat bottom surface with the internal cavity extending therefrom (last figure in publication, bottom), an enclosed insert (reference number 266) configured for insertion into the internal cavity and disposed therein (last figure in the publication), a light (last figure in publication, portion on top of part 266 within the boundary surface of reference number 266a) positioned within the enclosed insert positioned within the internal cavity for illuminating the wax body from within (last figure in publication, abstract). Brenchley et al. does not disclose a power source enclosed within the insert, a circuit board or a flickering means.

Jensen et al. discloses a power source (reference numbers 40 and 42) coupled to the light (Fig. 3) and contained in the enclosed insert within the internal cavity (Fig. 3, bottom), a circuit board (reference number 44) coupled to the light and power source (Fig. 3) and

contained in the enclosed insert within the internal cavity (Fig. 3) and flickering means (abstract) connected to the power source and light and configured for causing the light to flicker from within the enclosed insert and the cavity (abstract, Fig. 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the power source, circuit board and flickering means of Jensen et al. in the apparatus of Brenchley et al. to make the apparatus more portable and to generate a pleasing lighting effect. See Fig. 3 and the abstract of Jensen et al.

Concerning claim 2, Brenchley et al. does not specifically disclose a light emitting diode. Jensen et al. discloses the light as a light emitting diode (abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the LED of Jensen et al. in the apparatus of Brenchley et al. to reduce power consumption. See paragraph 0015 of Jensen et al.

Regarding claim 3, Brenchley et al. does not disclose a circuit board. Jensen et al. discloses a circuit board that is configured for controlling the voltage from the power source to the light emitting diode whereby the circuit board includes as flickering means a device capable of time variation of the current or voltage (paragraphs 0015 and 0026).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the power source, circuit board and flickering means of Jensen et al. in the apparatus of Brenchley et al. to make the apparatus more portable and to generate a pleasing lighting effect. See Fig. 3 and the abstract of Jensen et al.

Concerning claim 4, Brenchley et al. does not disclose a battery. Jensen et al. discloses the power source as a battery (reference numbers 40 and 42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the battery of Jensen et al. in the apparatus of Branchley et al. to make the apparatus more portable. See Fig. 3 of Jensen et al.

Regarding claim 14, Branchley et al. does not disclose a flickering means. Jensen et al. discloses the flickering means as one of an oscillator and a programmable microcontroller (oscillator, paragraph 0030).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the oscillator of Jensen et al. in the apparatus of Branchley et al. to create an aesthetically pleasing lighting effect. See the abstract of Jensen et al.

Concerning claim 15, Branchley et al. does not disclose a flickering means. Jensen et al. discloses the flickering means varying the voltage or the current over time (paragraph 0029).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the configuration of Jensen et al. in the apparatus of Branchley et al. to create an aesthetically pleasing lighting effect. See the abstract of Jensen et al.

Regarding claim 20, Branchley et al. discloses a wax body (abstract) with an internal cavity therein (last figure in publication, bottom), the wax body having a substantially flat bottom surface with the internal cavity extending therefrom (last figure in publication, bottom), an enclosed insert (reference number 266) configured for insertion into the internal cavity and inserted therein (last figure in the publication), a light source (last figure in publication, portion on top of part 266 within the boundary surface of reference number 266a; abstract) positioned within the enclosed insert positioned within the internal cavity for illuminating the wax body from within (last figure in publication, abstract). Branchley et al. does not disclose a disposable battery enclosed within the insert, a circuit board or a flickering means.

Jensen et al. discloses a disposable battery (reference number 40) contained within the enclosed insert positioned within the internal cavity (Fig. 3) and coupled to the light source (reference number 24, Fig. 3), a circuit board (reference number 44) having a flickering means thereon (paragraph 0015) and contained within the enclosed insert contained within the internal cavity (Fig. 3) wherein the flickering means is connected to the battery and to the light source (paragraph 0015) and is capable of time variation of at least one of current and voltage provided to the light source (paragraph 0029) causing the light source to flicker from within the internal cavity (abstract). (As stated above, Brenchley et al. discloses the light source within the insert; see the last figure in the publication.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the power source, circuit board and flickering means of Jensen et al. in the apparatus of Brenchley et al. to make the apparatus more portable and to generate a pleasing lighting effect. See Fig. 3 and the abstract of Jensen et al.

Concerning claim 25, Brenchley et al. does not specifically disclose a light emitting diode. Jensen et al. discloses the light as a light emitting diode (abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the LED of Jensen et al. in the apparatus of Brenchley et al. to reduce power consumption. See paragraph 0015 of Jensen et al.

3. Claims 8 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brenchley et al. in view of Jensen et al. as applied to claims 4 and 20 above, and further in view of Bonnema et al. (U.S. Publication 2003/0067770 A1).

Regarding claims 8 and 23, Brenchley et al. and Jensen et al. do not disclose the insert being made from a translucent material. Bonnema et al. discloses the enclosed insert as a translucent material (paragraph 0040).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the translucent material of Bonnema et al. in the apparatus of Brenchley et al. and Jensen et al. to protect the light source while allowing light to pass through the insert. See paragraph 0040 of Bonnema et al.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brenchley et al. in view of Jensen et al. and Bonnema et al. as applied to claim 8 above, and further in view of Lombardi (U.S. Patent 3,994,502).

Regarding claim 9, Brenchley et al. discloses the enclosed insert being affixed within the internal cavity (last figure in publication, bottom). Brenchley et al., Jensen et al. and Bonnema et al. do not specifically disclose a door.

Lombardi discloses a door for access to the power source which is replaceable (column 2, lines 15-20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the door of Lombardi in the apparatus of Brenchley et al., Jensen et al. and Bonnema et al. to access the batteries easily, making them easy to replace. See column 2, lines 15-20, of Lombardi.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brenchley et al. in view of Jensen et al, Bonnema et al. and Lombardi as applied to claim 9 above, and further in view of McKinney (U.S. Patent 6,669,352).

Regarding claim 10, Brenchley et al. discloses the enclosed insert as being of a cylindrical shape (paragraphs 0056-0057, last figure in publication). Brenchley et al. does not disclose the bottom end of the insert being coplanar with the bottom of the wax body. Jensen et al. discloses a bottom flat end planar with the flat bottom surface of the body (Fig. 3). Brenchley et al., Jensen et al., Bonnema et al and Lombardi do not disclose the top being of a semi-hemispherical shape.

McKinney discloses the top end being of a semi-hemispherical shape (Fig. 2, top).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the bottom end of the insert coplanar with the wax body as shown in Jensen et al. in the apparatus of Brenchley et al. so that the apparatus can easily sit on a table top. See Fig. 3 of Jensen et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the configuration of McKinney in the apparatus of Brenchley et al, Jensen et al., Bonnema et al. and Lombardi to "create aesthetically pleasing directional lighting along a path or walkway " (column 1, line 19, of McKinney).

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brenchley et al. in view of Jensen et al, Bonnema et al., Lombardi and McKinney as applied to claim 10 above and further in view of Klein (U.S. Patent 1,950,369).

Regarding claim 11, Brenchley et al., Jensen et al., Bonnema et al. and Lombardi et al. do not disclose the bottom flat end having a door with an access hole. McKinney discloses the bottom flat end defining an access hole (reference number 44) in which the door is positioned (reference number 40). McKinney does not disclose lips in the access hole or tabs in the door.



Klein discloses the access hole having intermittent radially extending lips that selectively hold the door in place (Fig. 3, left) via corresponding planarly outward extending tabs on the door (Fig. 3, right).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the access hole of McKinney in the apparatus of Brenchley et al., Jenson et al., Bonnema et al. and Lombardi to enable one to enable one to change the battery easily. See Fig. 2 of McKinney.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the lips and tabs of Klein in the apparatus of Brenchley et al, Jensen et al., Bonnema et al., Lombardi and McKinney to be able to remove the cap without the use of special tools while being able to secure the end of the apparatus as well. See Figs. 1 and 2 of Klein.

7. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brenchley et al. in view of Jensen et al. as applied to claim 3 above, and further in view of Lindner (U.S. Patent 5,490,045).

Regarding claim 12, Brenchley et al. and Jensen et al. do not specifically disclose the number of continuous hours of illumination the power source can provide. Lindner discloses a power source that lasts at least one hundred continuous hours of illumination (column 2, lines 29-30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the power source of Lindner in the apparatus of Brenchley et al. and Jensen et al. to provide a greater number of continuous hours of operation without changing the battery, thus saving money. See column 2, lines 29-30, of Lindner.

Regarding claim 13, Brenchley et al. and Jensen et al. do not specifically disclose the number of continuous hours of illumination the power source can provide. Lindner discloses a power source that lasts at least two hundred continuous hours of illumination (column 2, lines 29-30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the power source of Lindner in the apparatus of Brenchley et al. and Jensen et al. to provide a greater number of continuous hours of operation without changing the battery, thus saving money. See column 2, lines 29-30, of Lindner.

8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brenchley et al. in view of Jensen et al. as applied to claim 14 above, and further in view of Kitchen (U.S. Patent 2003/0198045 A1).

Regarding claim 16, Brenchley et al. and Jensen et al. do not specifically disclose a 555 timer. Kitchen discloses a 555 timer (paragraph 0026).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the low power 555 timer of Kitchen in the apparatus of Brenchley et al. and Jensen et al. so that the candle is able to operate for roughly 18 hours with 4 AA batteries, thus lengthening service life of a battery-operated apparatus. See paragraph 0026 of Kitchen.

9. Claims 14 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brenchley et al. in view of Jensen et al. as applied to claim 1 above, and further in view of Moore (U.S. Patent 6,688,752 B2).

Regarding claim 14, Brenchley et al. and Jensen et al. do not disclose a microcontroller. Moore discloses a programmable microcontroller (Fig. 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the microcontroller of Moore in the apparatus of Brenchley et al. and Jensen et al. to control a matrix of LEDs. See column 1, line 48, to column 2, line 8, of Moore.

Concerning claim 17, Brenchley et al. and Jensen et al. and Moore do not specifically disclose the microcontroller being programmed to provide random lighting.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to program the microcontroller of Moore in the apparatus of Brenchley et al. and Jensen et al. to provide random lighting. Since the microcontroller is well known in the art, it would have been obvious to one of ordinary skill in the art at the time the invention was made to program the microcontroller as desired to give a random lighting effect.

Concerning claim 18, Brenchley et al. and Jensen et al. do not disclose a programmable microcontroller programmed to provide flickering lighting. Moore discloses the programmable microcontroller (Fig. 2) being programmed to provide the flickering (abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the microcontroller of Moore in the apparatus of Brenchley et al. and Jensen et al. to control a matrix of LEDs. See column 1, line 48, to column 2, line 8, of Moore.

Regarding claim 19, Brenchley et al, Jensen et al. and Moore do not specifically disclose a programmable microcontroller programmed to provide patterned lighting.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to program the microcontroller of Moore in the apparatus of Brenchley et al. and Jensen et al. to provide patterned lighting. Since the microcontroller is well known in the art, it would have been obvious to one of ordinary skill in the art at the time the invention was made to program the microcontroller as desired to give a patterned lighting effect.

10. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brenchley et al. in view of Jensen et al. and Bonnema et al. as applied to claim 23 above, and further in view of McKinney.

Regarding claim 24, Brenchley et al. discloses the enclosed insert of a cylindrical shape (paragraphs 0056-0057, last figure in publication). Brenchley et al. does not disclose a bottom flat end planar with the flat bottom surface of the wax body. Jensen et al. discloses the bottom flat end planar with the flat bottom surface of the wax body (Fig. 3). Brenchley et al., Jensen et al. and Bonnema et al. do not disclose a top end of a semi-hemispherical shape and including a door therein for providing access to the battery and light source.

McKinney discloses a top end of a semi-hemispherical shape (Fig. 2) and including a door (reference number 40) for providing access to the battery and light source (Fig. 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the bottom end of the insert coplanar with the wax body as shown in Jensen et al. in the apparatus of Brenchley et al. so that the apparatus can easily sit on a table top. See Fig. 3 of Jensen et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the door of McKinney in the apparatus of Brenchley et al., Jensen et al. and Bonnema et al. to access the battery to change it easily. See reference number 40 (door) in Fig. 2 of McKinney.

### ***Response to Arguments***

11. Applicant's arguments filed September 21, 2005 have been fully considered but they are not persuasive. Applicant argues that Brenchley et al. teaches against the use of batteries. To the contrary, paragraph 38 also contains a statement that batteries could be used. An

embodiment with batteries is merely a less effective embodiment, not a teaching against the use of batteries. Batteries could be used (paragraph 0038), but they just are not the embodiment favored by the applicants of Brenchley et al. A less effective embodiment is not a teaching against using a certain type of technology. Most of the arguments stand or fall with Applicant's first assertion, and the rejections stand for the reasons delineated above.

Applicant goes on to argue that there is no motivation to modify Brenchley, Jensen or Bonnema to include the door of Lombardi in claim 9. To the contrary, the motivation is provided in the rejection in the second-to-last sentence. Applicant does not say why this motivation is improper, and the rejection stands. The same argument applies to claims 10, 11, 14 and 17-19. The motivations to combine are given in the sentences that begin with "It would have been obvious. . . .". Applicant does not say why the motivations are improper and the rejections stand.

Applicant also argues that Lindner is non-analogous art. In response to applicant's argument that Lindner is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Lindner deals with electric lighting, the Applicant's field of endeavor. Thus, Lindner is analogous art, and the rejection stands.

### ***Conclusion***

**12. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

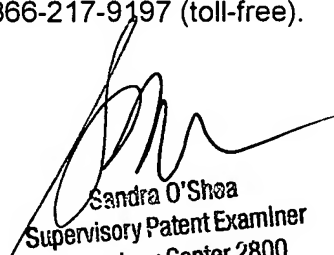
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon E. Payne whose telephone number is (571) 272-2379. The examiner can normally be reached on regular business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sep



Sandra O'Shea  
Supervisory Patent Examiner  
Technology Center 2800